

REMARKS/ARGUMENTS

Based upon the following remarks, and the addition of claims 17-20, Applicant respectfully requests reexamination and reconsideration of the application.

SUMMARY OF THE INVENTION

The present invention is concerned with a packaging tape system comprising adhesive boxing tape 10 having pre-printed indicia 12 thereon for the purpose of labeling a packed moving box according to the room, housing area, or office area from which the contents were retrieved/originated or the room in which the contents of the box are destined.

As described in the Background section of the present application, the present invention is intended to overcome the disadvantages associated with using a marker or writing instrument to write the contents of the box or the room from which it was packed on the box itself, or using labels, which comprise a two-step process. Writing on the box, or tape, may present handwriting which is not legible or too small to be seen at a distance. Also, the writing may be smeared by other boxes or the movers themselves. Once a box is written upon, either the box must be packed in the future according to the information previously written on it, or the previous writing must be scratched out. Another problem with using a marking pen is that the marking pen must be purchased in addition to the tape, and that the tape and marking pen must be located with one another at all times. If using labels, the consumer must purchase the labels in addition to the boxing tape. Moreover, the labels are very small rendering them difficult to read at a distance, and must be applied to several surfaces of the box in order that a mover can determine where the box originated without having to look at every side of the box.

The adhesive boxing tape 10 of the present invention is of a length sufficient to extend across a face of a box and seal two flaps of a box in a closed position, and as such is preferably formed in a dispensing roll (page 4, lines 6-8). The indicia 12 which is pre-printed on the tape and serves to label the box can label any box from any room in the house, for example, kitchen, bedroom, bathroom, dining room, living room, garage, storage room, office, study, den, family room, utility room, etc. Each roll of tape has the indicia printed repeatedly in sequence on the tape so as to indicate the room from which the contents of the box originated. The pre-printed indicia 12 can also relate to rooms and locations of an office, such as a breakroom, a conference room, a filing room, a reception area, an office, a computer room or department. (Page 4, second full paragraph).

In a preferred embodiment of the invention, each roll of boxing tape 14 is brightly colored to distinguish one room or area from another similar room or area. Thus, different colored tape can be used to identify different rooms with the same description, such as more than one bedroom or bathroom. (Last full paragraph page 4, and extending to page 5). Every roll of tape may be of a different color so as to further assist the movers from distinguishing the boxes of one room from another.

In use, articles 16 from one room or area of the house or office are placed within a moving box, and the appropriate roll of tape 14 bearing the indicia 12 relating to the room or location from which the articles came from is selected and the tape 10 dispensed from the roll 14 and onto the box 18 so as to cover substantially the length of opposing edges 22 of the box flaps 20 in order to simultaneously seal and label the box 18. (Last full paragraph of page 5, extending to page 6).

Instead of throwing away the boxes, or scratching out the old labels or markings, the tape 10 of the present invention is simply removed from the boxes and the boxes may be stored for later use. The present invention also eliminates the need to purchase marking pens, labels, and boxing tape to individually wrap and mark each box. This saves time in packing and loading. Moreover, the present invention can save a tremendous amount of time when unloading as the movers instantly know

which room or location the boxes sealed with the tape are to be placed in the new house or office.

ARGUMENTS - REJECTIONS UNDER 35 U.S.C. §103

The Office Action dated March 25, 2003 rejected claims 1-16 as being unpatentable over Hunter (U.S. Patent No. 6,138,832) in view of Williams (U.S. Patent No. 4,557,971).

Hunter discloses a packing kit including a plurality of different sized boxes or packing containers 18-30, packing instructions 12, rolls of tape 16 and inscribing means, such as a felt-tip or permanent marker. There is absolutely no disclosure whatsoever that the tape have pre-printed messages of any kind. In fact, in every single claim of the Hunter patent the inscribing means is included as a recitation. Moreover, in every instance of the specification itself, the marker or use of the marker is discussed.

Applicant respectfully asserts that the Hunter et al. reference actually teaches away from the claimed present invention as the present invention is intended to overcome the problems associated with the use of a marking pen or the like while packing residential or business goods for relocation. Thus, the Hunter reference is completely non-analogous to the present invention as its teachings are in direct conflict with the recitation of claims and intended purpose of the present invention.

Furthermore, in the rare case where the prior art does not appreciate the existence of the problem solved by the invention, Applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. In re Nomiya et al., 184 USPQ 607 612-613 (CCPA 1975).

The Office Action properly admits that the Hunter reference does not teach the tape having pre-printed indicia identifying rooms of the house such as the term "bedroom" and "bathroom". The Office Action combines the Hunter reference with Williams, which teaches of a multiple

layered laminated tape having a strength layer and a permeable layer which is suitable for printing or marking. Williams discloses in Column 2, lines 23-28 that the permeable layer may be written on by pen, marker or the like for addresses or for stamping of messages. The Williams reference also teaches that the tape may be pre-printed with messages such as the company name or frequently used warnings such as "fragile" or "handle with care".

The Office Action states that "it would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the tape of the packing kit taught by Hunter with pre-printed message as taught by Williams to provide a means to convey the destination or room contents of the carton". Applicant respectfully asserts that the Examiner has not provided sufficient support for this assertion, and that it has no basis.

As detailed in MPEP §2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed.Cir. 1983). As stated by the Federal Circuit, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *WL Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed.Cir. 1983).

The present invention resides in a packaging tape system having adhesive tape with pre-printed indicia which indicates a room or location in a house or office from which the contents of the box originated to facilitate moving, as described above and in the specification of the application. The Hunter patent discloses a packing kit which poses the very problems which Applicant's invention is intended to overcome. The Williams reference discloses an adhesive tape which can be marked upon or printed. However, there is no discussion in the Williams reference of any printed messages on the adhesive tape which would indicate the room or location in the house or office from which the contents of the box

originated for purposes of moving. Thus, when considering the claimed invention as a whole, the Hunter and Williams references do not render the claims of the present invention obvious.

With reference to MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 18 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Claims 1, 6, 17 and 19 all recite "indicia pre-printed on the adhesive tape indicating a room or location in a house or office from which the contents of the box originated." (emphasis added). Independent claims 9 and 14 recite that the adhesive tape has "pre-printed indicia thereon for indicating a room or location from which the articles were taken within a house or office". (emphasis added).

The Hunter and Williams references simply do not disclose or teach or even suggest these recitations. Rather, the Williams reference only teaches of messages such as "handle with care" or "fragile" or the company name or address information. It will be appreciated by those skilled in the art that none of these messages will provide the benefits of the present invention. As discussed in the attached Declaration of Chris Kreutner, an address label, or even tape bearing an address, would merely provide the mailing address of a box. This box would be delivered to the physical location of the address, but there would be no indication of the "room or location in the house or office from which the contents of the box originated", or the room or location in a house or office in which the contents of the box are intended to be destined.

Moreover, when moving, the contents of a house or office are not typically mailed with addresses through the Post Office, but rather are assembled in boxes and transported via a moving van or the like. Messages such as "handle with care" or "fragile" merely alert the handler of the box that the contents are fragile and subject to breakage. The

handler of the box has no idea in which room or location of a house or office the contents of the box originated from these messages.

Claims 4, 5, 7, 8, 10, 11, 15, 16, 17 and 19 recite the various rooms or locations of a house or office to which the pre-printed indicia would relate to, such as repeatedly labeling the tape with the word "bedroom". These recitations are simply not taught, disclosed or even suggested in either cited reference.

Claims 3, 6, 13, 14, 18 and 20 recite that each dispensing roll of tape be of a distinctive color so as to be readily visually distinguishable from another roll for indicating another room or location within the house or office. (emphasis added). The Williams reference in Column 2, line 21-23, merely states that the permeable layer of the tape may be colored to provide an esthetically pleasing tape. Thus, the Williams reference fails to disclose all the claim limitations of these claims as well.

Applicant's assertion that the claims are patentably distinct from the cited references is further supported by the pertinent case law. For example, in In re Miller, 164 USPQ 46 (CCPA 1969), the Examiner and the Board asserted that printed matter on measuring cups or measuring spoons were given no patentable weight. However, the Court of Customs and Patent Appeals reversed these decisions and found that the printed matter of Miller's invention was functionally related to the volume measuring device.

The Federal Circuit in In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), expounded upon the Miller decision. The sole difference between the appealed claims of the Gulack application and the Wittcoff reference resided in the content of the printed matter. In re Gulack, at 403. The Federal Circuit held that differences between the inventions and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. The Federal Circuit stated that "under section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claims must be read as a whole." The Federal Circuit further stated that "what is required is the existence of *differences*

between the appealed claims and the prior art sufficient to establish patentability.”

The Federal Circuit reversed the Board and the Examiner and held that there was a functional relationship between the printed matter and the substrate of the appealed claims, and that the relationship between the printed matter and the substrate differed from the relationship exhibited by the corresponding elements of the Wittcoff reference.

Similar to the In re Gulack case, the pre-printed indicia of Applicant's packaging tape is different in content than the printed matter of the Williams tape. Moreover, the relationship between the printed matter and the tape in the present application is substantially different than the relationship between the printed matter and the tape of the Williams reference. Instead of merely providing company name, address or warning messages, the pre-printed indicia of the tape of the present invention “indicates a room or location in a house or office from which contents of the box originated”. That is, the pre-printed indicia assists the movers in determining which room or location in a house or office the contents originated and to which room or location in the new house or office the box should be placed. Such is simply not disclosed or even suggested in the Williams reference.

Similar to the Hunter reference, the Williams reference does not appreciate the existence of the problem solved by the present invention, which is, in itself, strong evidence of the non-obviousness of the invention.

As discussed in the attached Declaration, the present invention has been accepted enthusiastically in the market place and has had great success. Such reception would likely not have been as enthusiastic and as profitable if Applicant's packaging tape were not new or were merely an obvious variation of something already known. Such evidence further argues against the obviousness of Applicant's claimed invention.

CONCLUSION

As discussed above, when considering the invention as a whole, neither the Hunter or Williams references render the claimed invention obvious. In fact, the Hunter reference actually teaches away from the claimed invention. Moreover, neither the Hunter nor Williams references meet the *prima facie* standard of obviousness as neither disclose or teach all of the claim limitations of any of the independent claims. As stated by the Federal Circuit in the In re Gulack decision, "one cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole." As the pre-printed indicia of Applicant's tape imparts a functional difference between it and the Williams tape, neither the Williams or Hunter references render the claims of the present invention obvious. As such, Applicant respectfully asserts that all currently pending claims 1-20 are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

KELLY BAUERSFELD LOWRY & KELLEY, LLP



Aaron T. Borrowman
Registration No. 42,348

ATB/kr
6320 Canoga Avenue, Suite 1650
Woodland Hills, California 91367
(818) 347-7900